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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,972	01/07/2004	Thomas C. Frampton	2171-44693	4820

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EXAMINER	
WHITE, DWAYNE J	

ART UNIT	PAPER NUMBER
3745	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/752,972	FRAMPTON, THOMAS C.	
	Examiner	Art Unit	
	Dwayne J White	3745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) *41-47* is/are allowed.

6)☒ Claim(s) *1-9,12 and 17-40* is/are rejected.

7)☒ Claim(s) *10,11 and 13-18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/7/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,726,451. This is a double patenting rejection. The application claims are virtually identical with the exception of the patent the limitation of the housing having an exterior surface. Since it is inherent that a housing would have an exterior surface, the patented claims would literally infringe the application claims and visa versa.

Claims 2, 3, 4, 5, 6, 7, 8, 9 and 12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11, 12, 13, 16, 14, 17, 15, 18 and 19 respectively, of prior U.S. Patent

No. 6,726,451. This is a double patenting rejection. The application claims are virtually identical to the patent claims with the exception that the patent claims a rotatable shaft where as the application claims just a shaft. Since it is inherent that a shaft connected to a motor would rotate, the patented claims would literally infringe the application claims and visa versa

Claims 20-28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2-10, respectively of prior U.S. Patent No. 6,726,451. This is a double patenting rejection. The application claims are virtually identical to the patent claims with the exception of the limitation of the housing having an exterior surface. Since it is inherent that a housing would have an exterior surface, the patented claims would literally infringe the application claims and visa versa.

Claims 29-38 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 28, 29, 31, 30 and 32-37, respectively, of prior U.S. Patent No. 6,726,451. This is a double patenting rejection. The application claims are virtually identical to the patented claims with the exception that the patented claims recite the shaft as being "rotatable" and the intended use for the shaft, "so that the motor can turn the shaft about the shaft's longitudinal axis." Since these "features" do not make the application claims patentably distinct from the patent claims, it is clear that the application claims would literally infringe upon the patented claims and visa versa.

Claim 39 rejected under 35 U.S.C. 101 as claiming the same invention as that of claim39 of prior U.S. Patent No. 6,7226,451. This is a double patenting rejection. The application claims are virtually identical to the patented claims with the exception that the patented claims recite the shaft as being "rotatable" and the intended use for the shaft, "so that the motor can turn the shaft

about the shaft's longitudinal axis." Since these "features" do not make the application claims patentably distinct from the patent claims, it is clear that the application claims would literally infringe upon the patented claims and visa versa.

Claim 40 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 40 of U.S. Patent No. 6,726,451. Although the conflicting claims are not identical, they are not patentably distinct. Claim 40 of the patent "anticipates" application claim 40. Accordingly, application claim 40 is not patentably distinct from patent claim 40. Here, patent claim 40 requires:

"A blade mounting arrangement for a ceiling fan of the type that typically includes a downrod for supporting the fan from the ceiling, a motor, a shaft rotatably connected to the motor so that the motor can turn the shaft about the shaft's longitudinal axis, a motor housing supported by the shaft, and fan blades mounted for rotation to the fan at spaced positions circumscribing the shaft, wherein, upon rotation, the blades define a circle of rotation, and the fan achieves a center of rotational gravity that lies on the shaft's longitudinal axis as a result, the blade mounting arrangement comprising: at least two fan blades connected for rotation to the fan and extending in one semicircle of rotation; a stabilizing member extending from the fan in a second semicircle of rotation relative to the at least two fan blades, wherein the stabilizing member stabilizes the rotating weight of the blades upon rotation of the fan such that the center of rotational gravity of the fan lies on the longitudinal axis of the shaft; and, a motor housing supported by the shaft, the housing having an upper casing and a lower casing, wherein the lower casing is free to rotate about the longitudinal axis relative to the upper casing."

While application claim 40 only requires:

"A blade mounting arrangement for a ceiling fan of the type that typically includes a downrod for supporting the fan from the ceiling, a motor, a shaft rotatably connected to the motor so that the motor can turn the shaft about the shaft's longitudinal axis, a motor housing supported by the shaft, and fan blades mounted for rotation to the fan at spaced positions circumscribing the shaft, wherein, upon rotation, the blades define a circle of rotation, and the fan achieves a center of rotational gravity that lies on the shaft's longitudinal axis as a result, the blade mounting arrangement comprising: at least two fan blades *asymmetrically* connected for rotation to the fan and extending in one semicircle of rotation; a stabilizing member extending from the fan in a second semicircle of rotation relative to the at least two fan blades, wherein the stabilizing member stabilizes the rotating weight of the blades upon rotation of the fan such that the center of rotational gravity of the fan lies on the longitudinal axis of the shaft; and, a motor housing supported by the shaft, the housing having an upper casing and a lower casing, wherein the lower casing is free to rotate about the longitudinal axis relative to the upper casing."

Thus it is apparent that the more specific patent claim 40 encompasses application claim 40. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 40 is anticipated by Patent claim 40 and since anticipation is the epitome of obviousness, then Application claim 40 is obvious over Patent claim 40.

CONCLUSION

Allowable Subject Matter

Claims 41-47 are allowed.

Claims 10, 11, 13-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne J White whose telephone number is (571) 272-4825. The examiner can normally be reached on 7:30 am to 5 pm T-F and alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571) 272-4820. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dwayne J White

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5/31/05